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Patent

Attorney Docket No. 1005950-000845

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Jeremy E. Dahl et al.

Application No.: 10/758,679

Filing Date: January 15, 2004

Title: LUMINESCENT  
HETERODIAMONDOIDS AS  
BIOLOGICAL LABELS

)  
)  
) Group Art Unit: 1641

)  
) Examiner: DAVID J VENCI

)  
) Confirmation No.: 4958

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is enclosed.
- ☐ \_\_\_\_\_ Terminal Disclaimer(s) and the ☐ \$ 65 ☐ \$ 130 fee per Disclaimer due under 37 C.F.R. § 1.20(d) are enclosed.
- ☐ Also enclosed is/are: \_\_\_\_\_
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$ 395 ☐ \$ 790 fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted \_\_\_\_\_ on \_\_\_\_\_ for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least \_\_\_\_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims				x \$ 50 (1202)	\$ 0
Independent Claims				x \$ 200 (1201)	0
<input type="checkbox"/> If Amendment adds multiple dependent claims, add \$ 360 (1203)					\$ 0
Total Claim Amendment Fee					\$ 0
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					0
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0


- ☐ Charge \_\_\_\_\_ to Deposit Account No. 02-4800 for the fee due.
- ☐ A check in the amount of \_\_\_\_\_ is enclosed for the fee due.
- ☐ Charge \_\_\_\_\_ to credit card for the fee due. Form PTO-2038 is attached.
- ☒ The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date November 9, 2006

By:

  
Melissa M. Hayworth  
Registration No. 45,774

P.O. Box 1404  
Alexandria, VA 22313-1404  
703 836 6620



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
Jeremy E. Dahl et al.	)	Group Art Unit: 1641
Application No.: 10/758,679	)	Examiner: DAVID J VENCI
Filed: January 15, 2004	)	Confirmation No.: 4958
For: LUMINESCENT	)	
HETERODIAMONDOIDS AS	)	
BIOLOGICAL LABELS	)	

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully traverse the restriction requirement set forth in the Office  
Action dated October 10, 2006.

In the Office Action, the Examiner sets forth a restriction requirement among two  
groups of the claims:

Group I - claims 1-28 drawn to a diamondoid label.

Group II - claims 29-40 drawn to a method using a diamondoid label.

Applicants respectfully assert that the inventions of Group I and Group II should  
properly be examined together. The inventions of Group I and Group II both involve a  
diamondoid label; therefore, the claims Group I and Group II are related.

The Examiner contends that the inventions of Group I and Group II are patentably  
distinct because the inventions are related as product and process of use. The Examiner  
asserts that the inventions can be shown to be distinct if either or both of the following can be  
shown: (1) the process for using the product as claimed can be practiced with another  
materially different product or (2) the product as claimed can be used in a materially different  
process.

Applicants note that the inventions of Groups I and II are so closely related that a proper search of any of the claims would, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study separate patents in order to have available all of the issued patent claims covering Applicant's invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicant.

Regardless of whether the two inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicants provisionally elect, with traverse, to prosecute the invention of Group II, namely Claims 29-40.

Applicants earnestly solicit favorable consideration of the above response and early passage to issue the present application. The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.


Applicants reserve the right to file a divisional application covering the subject matter of the non-elected claims.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: November 9, 2006

By:

  
Melissa M. Hayworth  
Registration No. 45,774

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